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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,262

01/23/2004

Wallace Grubb

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5536

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EXAMINER

MACKEY, JAMES P

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,262

Applicant(s)

GRUBB, WALLACE

Examiner

James Mackey

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10, 11, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 6-9, 12-14, 17 and 18 is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/23/2004</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18, drawn to a surface treatment apparatus, classified in class 425, subclass 385.
  - II. Claims 19-20, drawn to a method for surface treating a concrete block, classified in class 264, subclass 138.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II and Group I are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case, the process can be practiced by another and materially different apparatus, since the method does not require a frame or a selectively powered hammer actuator carried by the frame capable of selectively moving the hammer member (the method could achieve the same results by moving the hammer member by hand). Further, the apparatus could be used to practice another and materially different process, such as texturing wood or plastic.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Louis Martineau on 01 March 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 19-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hess et al. (U.S. Patent 6,685,459).

Hess et al. teach a surface treatment machine 1 comprising plural elongated hammer members 27, which may comprise a flexible elongated chain support element including chain link strikers (Figure 4), mounting means for mounting first and second extremities to a frame 20, 22 (via disks 25 and shaft 21), and a selectively powered actuator 23, 24 carried by the frame for selectively moving the extremities concomitantly with the intermediate portion of the hammer members between first positions to clear the blocks and second positions (shown in dashed line in Figure 3) to impact the block.

7. Claims 11, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application 894,590 (Figure 6).

EP 894,590 teaches a surface treatment machine comprising a hammer member 34 mounted to a frame via a reciprocating pivotable hammer support 32, 33, and an actuator 35, 36

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for selectively and reciprocatingly moving the hammer member between a first position to clear the blocks and a second position to impact the block.

8. Claims 11, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Suto et al. (U.S. Patent 6,803,002; Figures 7-8).

Suto et al. teach a surface treatment machine comprising a hammer member 705 mounted to a frame via a reciprocating pivotable hammer support 702, 704, and an actuator 710 for selectively and reciprocatingly moving the hammer member between a first position to clear the blocks and a second position to impact the block.

9. Claims 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application 339,308.

EP 339,308 teaches a surface treatment machine comprising hammer members 26 (Figures 1-2) mounted to a frame via a reciprocating hammer support 25 (Figure 5), and an actuator 35 (Figures 3 and 5) for selectively and reciprocatingly moving the hammer members between first positions to clear the blocks and second positions to impact the block.

10. Claims 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Document 100 61 464.

German '464 teaches a surface treatment machine comprising hammer members 8 mounted to a frame via a reciprocating hammer support 4, 19, and an actuator 16-18 for selectively and reciprocatingly moving the hammer members between first positions to clear the blocks and second positions to impact the block.

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11. Claims 6-9, 12-14, 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach or fairly suggest a surface treatment machine wherein an elongated hammer member is mounted at first and second extremities spacedly carried by the frame, with mounting means for mounting the hammer member to the frame while allowing movement of the hammer member between a first position to clear the blocks and a second position to impact the block, wherein a hammer actuator moves the hammer member (hammer support) in a reciprocating motion, as claimed in claims 8, 12 and 17. The prior art of record does not teach or fairly suggest a surface treatment machine wherein an elongated hammer member is mounted at first and second extremities spacedly carried by the frame, with mounting means for mounting the hammer member to the frame while allowing movement of the hammer member intermediate portion between a first position to clear the blocks and a second position to impact the block, wherein the hammer member comprising an elongated support element carrying strikers at the intermediate portions, the strikers being movable with respect to one another, and wherein the strikers are rigid striker rings, as claimed in claims 6 and 7.

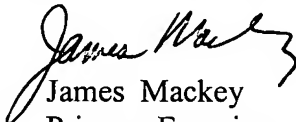
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James Mackey  
Primary Examiner  
Art Unit 1722  
3/4/06

jpm  
March 4, 2006